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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1930.

No. 315

HANNAH M. SMITH, Administratrix of Estate of Owen P. Smith,

Petitioner,

versus

SPRINGDALE AMUSEMENT PARK LIMITED, PAUL M. WILLIAMS and GERALD BROWN.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

JOHN E. SATER,
E. HOWARD M'CALEB,
Counsel for Petitioner.

MONTGOMERY-ANDREWS PRINTING CO. INC., 430-438 CHARTRES, N. O.

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SPRINGDALE AMUSEMENT PARK LIMITED, PAUL M. WILLIAMS and GERALD BROWN.

PETITION FOR WRIT OF CERTIORARI.

May It Please the Court:

The petition of Hannah M. Smith, Administratrix of the Estate of Owen P. Smith, respectfully shows to this Honorable Court:

—A—

SUMMARY STATEMENT OF THE MATTER INVOLVED.

This is an equity suit for infringement of petitioner's patents relating to devices used in dog racing amusement (R. p. 1 to 13, R. p. 60), being Patent No. 1,379,224, claims 1 and 2, (R. pp. 3, 60, 186 to 191); Pat-

ent No. 1,507,439, Claim 1, (R. pp. 4, 60, 222 to 224) and Patent No. 1,507,440, claims 1, 2, 3, (R. pp. 5, 60, 254 to 256). As the reasons for allowance of the writ are concerned with these three patents we omit reference to other patents withdrawn (R. p. 60) and to those parties defendant (other than respondents) who were dismissed (R. p. 100). Among other matters not material or not decided, respondents answered, denying validity of these patents and, if valid, they denied infringement (R. pp. 21, 23, 25, 26, 27, 31, 32, 36, 37, 38, 40, 41, 45). After hearing (R. p. 68 to 88) the District Judge decided that Claims 1 and 2 of Patent No. 1,379,224, for a dog racing device were valid but not infringed (R. p. 100); that Patent No. 1,507,440 for a housing for concealing tracks and cars having a laterally extending arm in a dog racing device was invalid but if valid was not infringed (R. p. 100) and Patent No. 1,507,439 for starting cage for racing dogs is valid but not infringed (R. p. 100) and accordingly dismissed the bill (R. p. 100). Petitioner thereupon appealed to the United States Circuit Court of Appeals for the Sixth Circuit (R. p. 101 to 107) and, after hearing, said Sixth Circuit Court of Appeals affirmed the aforesaid decision of the District Court (R. p. 368). Petition for rehearing was timely filed on May 14, 1930 (R. p. 373), and, on June 12, 1930, the petition for rehearing was denied. (R. p. 407).

(a) Summary as to Patent No. 1,379,224 Claims 1 and 2.—For brevity sake, Claim No. 1 substantially describes the invention. In a dog racing amusement, it claims (a) a race track suited for dogs, (b) a casing extending around the outer side of the race course and provided with a longitudinal opening; (c) a mechanical con-

veyor including a track extending around the race course and located within the casing; (d) a conveyor car mechanically operated upon said track and provided with an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure; (e) and a wheel rotatably mounted on and supporting the arm at the projecting end thereof. (R. p. 191, lines 36 to 49). Claim No. 2 is substantially the same as Claim No. 1 save the omission of a casing and a longitudinal opening in said casing, substituted by a covered rail track, and save by the addition of a platform supported by the horizontal lure carrying arm and a lure on the platform (R. p. 191, lines 50 to 60). In his specifications, the patentee states that the invention consists of the arrangement and combination of parts described and claimed and that it is not restricted to the exact details of construction disclosed herein (R. p. 189, lines 25 to 34), and that the arm is hinged to the conveyor car and supported at its outer end by a wheel 28 rotatably mounted (R. p. 190, lines 9 to 17). The essential facts are not in dispute; comparison of the two claims with respondents' device (R. pp. 71, 72, 73, 75, 76, 77, 78, 117, 140, 147, 148) shows an appropriation of the claim except that respondent's lure carrying arm is pivoted to the car or rigidly supported by super-imposed disc welded to the arm at the connecting end of the arm in lieu of the wheel support at the projecting end.

(b) Summary as to Patent No. 1,507,440 and the Claims Thereof.—In a housing for covering tracks and cars having laterally extending arm operated on said track, the combination of (a) posts set in the ground at the sides

of said track, (b) timbers attached to said posts to form a frame, (c) boards attached to said timbers and posts to form a continuous enclosure above said track, and having a continuous opening in one side of said housing adapted to permit extension of the laterally extending arm there through; (d) and truss rods attached to the closed side of the housing adapted to support the side of said housing above the said continuous opening. (R. p. 255, lines 97 to 110). In his specifications, the patentee says, that the invention is not restricted to the exact details of construction (R. p. 255, lines 24 to 34); and claims 2 and 3 provided adjustable stay rods and adjustable screw threaded stay rods (R. pp. 255, 256) instead of the truss rods of Claim No. 1. The essential facts are not in dispute; comparison of the Claim No. 1 with respondents' housing device (R. pp. 71, 73, 75, 76, 117, 140), shows a literal translation of Claim No. 1.

(c) Summary as to Patent No. 1,507,439, for Starting cage.—The single claim of this patent substantially describes the invention. In a starting cage for racing dogs (1) a frame comprising a box like structure divided into a plurality of compartments and comprising walls formed of wire mesh partially covered with fabric, (2) individual rear doors for each of the compartments and (3) a single front door hinged at its upper end to the top walls of the frame, (4) divergent inclined members secured to the top of the said frame and (5) extending upwardly and outwardly beyond the face of the front door and having their outer ends in the plane of the side walls of the box like structure, (6) springs secured to the outer ends of said inclined members and to the door and lying in the plane of

the hinges, (7) and a latch at the bottom of the cage for co-action with the lower edge of the front door to hold the front door normally closed against the tension of said springs, said springs adapted to raise the front door upon release of the latch. (R. pp. 223, 224). In his specifications the patentee states that the invention consists of the arrangement and combination of parts as thereinafter described and claimed, and that it is not restricted to the exact details of construction disclosed herein (R. p. 223, lines 25 to 34); and he further states that it will be apparent that other means may be employed for raising the front door (6) and other means may be employed to protect the dogs against injury in the stalls, without departing from the spirit of (my) said invention (R. p. 223, lines 79 to 83. The essential facts are not in dispute. Comparison with this single claim of the patent with respondents' starting cage (R. pp. 71, 72, 73, 75, 76, 118, 140 photographs 3, 4, 5) shows an appropriation of the claim, except that respondents' cage has partitions formed of plain boards instead of wire mesh partially covered with fabric, parallel instead of divergent inclined members, and elastic rubber springs instead of the springs broadly called for in the claim.

Short statement of matter involved.—As to patent No. 1,379,224, the matter involved is (1) whether or not respondents' rigid support of the horizontal lure carrying arm is equivalent to the movable support of that arm as described and claimed in the patent and (2) whether or not the claims are expressly limited, either by the language of the description or claims or by any disclaimers, estoppels or abandonment in the patent office proceedings as to that

form of support of the horizontal lure carrying arm, and (3) whether or not the respondents have infringed the claims.

And further the question is (1) whether this patent is of primary character, or if not, whether it is of relatively high generic rank or of major grade, or whether it has substantially advanced the art, entitling the patentee (petitioner) in either case, to a liberal construction and to a range of equivalents measured by the leap or distinct step made over the prior art; (2) whether either or both of these claims are restricted to the outfield outer side of the race course and to the movable (wheel) support of the horizontal lure carrying arm; (3) whether infringement is avoided by placing the apparatus on either side of the race course and by the substitution of a rigid for the movable (wheel) support; (4) whether the essence of the invention is the horizontal lure carrying arm, or the lure carrying arm extending through a continuous longitudinal opening of the casing in a projecting position over the track; (5) whether or not, the movable (wheel) support of said arm pertains to the working environment of the aforesaid inventive step; (6) whether the patentee is deprived of equivalents of such accessorial element of support of the arm as also the location of the apparatus described and claimed in his preferred form, there being no limitation imposed by the prior art, the specifications, or the patent office proceedings, and no disclaimer of equivalents therefor expressed therein or implied by the prior art.

As to patent No. 1,507,440, and the claims thereof, the matter involved is whether or not this patent is invalid either for want of invention or novelty. And if valid,

whether or not respondents' copy of Claim No. 1 avoids infringement, or as to Claims 2 and 3 whether or not the changes involving adjustability or not of the stay rods avoid infringement.

As to patent No. 1,507,439, and the single claim thereof, the matter involved is whether or not this patent is valid, and if valid, whether or not the substitution of wooden boards for wire mesh partitions, parallel for divergent inclined members and elastic rubber springs for "springs" avoid infringement.

And further, whether or not the distinguishing characteristic of this the first and only starting cage for racing dogs, by reference for the sake of argument only to the horse starting art, is the hinging of the exit door to the top walls of the frame with inclined members secured to the top of the frame extending upwardly and outwardly co-acting with tension springs for quick movement of the hinged exit door upon release of the latch; (2) whether or not wire mesh forming the partition walls are accessorial to the device or its operation, and their primary function for separating the dogs in the cage changed or impaired by the substitution of wooden boards, (3) whether or not in view of the special reservation contained in the four corners of the patent, the expressly stated preferred form and kind of material for separation of the stalls with no change, (except possibly by impairment) of function operation and result has been disclaimed in the patent office proceedings or otherwise resolved into an express limitation; (4) whether or not the expressly stated preferred form of springs or spring support claimed, finds equivalency in

respondents' form of springs or spring support, with no substantial change in function, operation and result.

—B—

REASONS RELIED ON FOR ALLOWANCE OF WRIT.

(1) As to Patent No. 1,379,224, Claims 1 and 2. The decision of the Sixth Circuit Court of Appeals denying infringement is in conflict with the decision of the Fifth Circuit Court of Appeals on the same matter (Rule 38, Sec. 5 [b]). See *American Electric Rabbit Racing Association, George W. Heintz and others, versus Smith, 26 Fed. (2nd Series), 1016,* wherein this patent and the infringing device described in the opinion of the District Court in *Smith v. American Electric Rabbit, etc., et al., 21 Fed. (2nd Series), 366,* are referred to and the "conclusions" of the District Court were agreed to by the Fifth Circuit Court of Appeals in its decision. The main conclusion in *Smith v. American Electric Rabbit, etc., et al., 21 Fed. (2nd) 366,* so agreed to in *American Electric Rabbit, etc., et al., v. Smith, 26 Fed. (2nd), 1016,* is, that the location of the apparatus at either outer side of the race course and the functions performed by the wheel or movable support of the horizontal-lure-carrying arm are served by the rigid arm, in consequence of which equivalency obtains and infringement not avoided. In the decision of the Sixth Circuit Court of Appeals, that conclusion is to the contrary (R. p. 368). In the decision of the Sixth Circuit Court of Appeals, it is concluded that the scope of each claim is limited to the outfield outer side, as distinguished from the infield outer or left side of the race course, and to a movable support of the horizontal arm, by a self imposed limitation contained in the Patent specifications and

in the Patent office proceedings, whereby the patentee disclaimed all forms of support of the fundamental element of a horizontal lure carrying arm other than the movable support and therefore the form of rigid support averted infringement of the claim (R. pp. 368, 371). The decision of the Fifth Circuit Court of Appeals in agreement with the conclusions of the District Court in *Smith v. American Electric Rabbit Racing Association, et al., 21 Fed. (2nd) 366*, is to the contrary wherein it appears upon consideration of the Patent and the Patent office proceedings *(21 Fed. [2nd]* at *page 368* and at *page 371)* to the effect that "There is nothing to show (his) intention to relinquish to the public all forms in which his invention might be embodied."

In each case the validity of the Patent is assumed by the Courts, the conflict in each decision being, as to the scope of the claims, the documentary interpretation arising from the face of the patent and the Patent Office record, and infringement of the claims. The infringing device described in the Fifth Circuit Court of Appeals decision and the infringing device described in this case are substantially identical, both being constructed under patent to Creveling (R. pp. 76, 77, 78, 147, *et seq.), 21 Fed. (2nd) 368, 369*, so that extrinsic evidence is not needed to apply in either of them to the patent specifications and claims, as from a mere comparison of the patented device and the infringing device in each case the conflict of decision is manifest.

(2) As to Patent No. 1,507,440. The decision of the Sixth Circuit Court of Appeals denying the validity of this patent concedes that it is in conflict with the decision

of the Fifth Circuit Court of Appeals upholding its validity in virtue of its agreement in the conclusions of validity as appears from the opinion in *Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366*, at *page 373*, (Rule 38, Sec. 5 (b). For the Sixth Circuit Court of Appeals says: "In holding patent No. 1,507,440, invalid for lack of invention, the Court (meaning the District Court) was at variance with the District Court of the Eastern District of Louisiana *(21 Fed. [2nd] 366)* and the Court of Appeals of the Fifth Circuit *(26 Fed. [2nd] 1016)* (R. p. 369). And the Sixth Circuit Court of Appeals affirms the decree of the District Court (R. pp. 368, 372) which decides that this patent is invalid. (R. p. 100). This conclusion is in direct conflict with that of *21 Fed. (2nd) 366, supra*, at *page 373*, where it is concluded "the file wrapper," etc., "* * * satisfies me that Smith's application of the known principles of his housing device in the art or field of dog racing was a novelty." Manifestly, therefore, the validity of this patent was sustained by the Fifth Circuit, and its validity denied by the Sixth Circuit.

(3) As to Patent No. 1,507,439 and the single claim thereof, the decision of the Sixth Circuit Court of Appeals is in conflict with the decision of the Fifth Circuit Court of Appeals on the same matter (Rule 38, Sec. 5 [b]). The conclusions of the opinion in *Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 266, supra*, incorporated in the decision of the Fifth Circuit Court of Appeals in *American Electric Rabbit Racing, etc., v. Smith, 26 Fed. (2nd) 1016, supra*, are substantially to the effect that the defendants in that case have infringed this patent, whereas in affirming the decree of the District Court deciding that the patent is valid but not infringed (R. p. 100), the Sixth

Circuit Court of Appeals has decided contrary to the Fifth Circuit decision.

In the infringing device of the Fifth Circuit case and in this case, the ordinary wooden board partitions are substituted for the wire mesh partitions of the claim, aeroplane shock rubber or elastic rubber springs are substituted for "springs", the difference being as to the change of location of the inclined members from divergent to parallel. The decision of the Sixth Circuit Court of Appeals in affirmance with the District Court is, that these substitutions and changes avoid infringement (R. pp. 100, 368, 372), whereas the decision of the Fifth Circuit case is to the contrary. See *Smith v. American Electric Rabbit, etc., 21 Fed. (2nd), 366*, at *pages 374, 375, 376*, agreed to by the Fifth Circuit Court of Appeals in *21 Fed. (2nd), 1016, supra*, assuming the validity of the claim in view of the prior art and patent office proceedings *(21 Fed. [2nd] 374, 375)*, that the plaintiff (petitioner here) in that case, was entitled to equivalents and that the substitution of wooden board partitions for wire mesh partitions and of elastic rubber or shock rubber springs in the infringing starting cage in that case, and a change in location of the inclined members, were equivalents and obviously designed for the purpose of evading the spirit of the invention claimed, involving impairment of function and so colorable as to constitute infringement.

In each case, the devices charged as infringements are substantially identical, save that in the Fifth Circuit case there was some question as to whether these inclined members had their outer ends in the plane of the side walls, whereas in this case they are parallel and this im-

material difference was considered and decided by the Fifth Circuit Court of Appeals as follows: "assuming that they were, however, my conclusion is that, whatever difference there might be in location, position, or length of the divergent members, they were for all practical purposes identical with those of Smith, and, under the authorities already considered, the change of position or location of an element, which is substantially the same, functioning in substantially the same way to obtain the same result, cannot avert a charge of infringement" *(21 Fed. [2nd] 376)*.

WHEREFORE, your petitioner respectfully prays that a writ of *certiorari* be issued out of and under the seal of this Honorable Court directed to the United States Circuit Court of Appeals for Sixth Circuit, commanding that court to certify and to send to this court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket No. 5335, *Hannah M. Smith, Administratrix of Estate of Owen P. Smith, Appellant, v. Springdale Amusement Park Limited, et al., Appellees*, and that the said decree and judgment of the United States Circuit Court of Appeals for the Sixth Circuit may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

HANNAH M. SMITH, ADMINISTRATRIX OF ESTATE OF OWEN P. SMITH, DECEASED.
By JOHN E. SATER,
E. HOWARD M'CALEB,
Counsel for Petitioner.

BRIEF IN SUPPORT OF FOREGOING PETITION FOR CERTIORARI.

—I—

The Opinions of the Courts Below.

(a) Opinion of District Court in *Smith v. Springdale Amusement Park, Limited, et al.*, see Pamphlet No. 1, *39 Fed. (2nd) p. 92;* see also R. p. 89 (b), Opinion U. S. Circuit Court of Appeals, Sixth Circuit, in *Smith v. Springdale Amusement Park, Limited, et al.*; No. 5335 of the docket of said Court is dated April 15, 1930, not yet reported, and copied in R. pp. 368 to 372.

—II—

Jurisdiction.

(a) Statutory provision believed to sustain the jurisdiction is Judicial Code, Section 240 (a), as amended by Act Congress February 13, 1925, Chap. 229, 43 Stat. 936; (b) date of decree sought to be reviewed is April 15, 1930 (R. p. 368), rehearing denied June 12, 1930 (R. p. 407); date of filing petition for certiorari, see filing date stamped by Clerk of this Court on cover of petition for certiorari; (c) nature of case, is an equity suit for infringement of claims 1 and 2 of Patent No. 1,379,224, (R. pp. 1, 3, 60, 186 to 191); Claims 1, 2, 3 of Patent No. 1,507,440 (R. pp. 1, 5, 60, 254 to 256); Claim 1 of Patent No. 1,507,439 (R. pp. 1, 4, 60, 222 to 224); (d) Rulings below: The District Court ruled that the above stated claims of Patent No. 1,379,224 were valid but not infringed (R. p. 100), that Patent No. 1,507,440 was invalid (R. p. 100), and that the single claim of Patent No. 1,507,439 is

valid but not infringed (R. p. 100). On appeal therefrom, the Sixth Circuit Court of Appeals affirmed the ruling. (R. p. 368); (e) Cases believed to sustain the jurisdiction *Mangum Import v. Coty, 262 U. S. 159; Sanitary Ref. Co. v. Winters, 280 U. S., p. 30.*

—III—

Statement of the Case.

A statement of the case has been given under heading A of the petition for certiorari. Supplemental thereto it may be noted, that with the exception of the apparatus represented by Patent No. 1,507,439, the apparatus represented by Patent No. 1,379,224 and No. 1,507,440 in this case and the case of *Smith v. American Electric Rabbit*, etc., Fifth Circuit Court of Appeal, and the case of *Smith, Petitioner, v. Magic City Kennel Club, Inc., et al.*, No. 77, October term, 1930, of the docket of this Court in which the petition for certiorari has been granted under No. 809, October term, 1929, are substantially identical. Infringement of starting cage Patent No. 1,507,439 is not involved in *Smith, Petitioner, v. Magic City Kennel Club*, No. 77, October term, 1930, certiorari granted, but infringement thereof was presented and decided favorably to petitioner in the Fifth Circuit case *(26 Fed. [2nd] 1016 and 21 Fed. [2nd] 366)*, and decided adversely to petitioner by the Sixth Circuit Court of Appeals (R. p. 368); the starting cage in both cases being substantially identical, save that in the Fifth Circuit case two of the inclined members were divergent and one non-divergent, whilst in this case these inclined members are non-divergent. See also *sub nom Heintz and American Electric Rabbit Racing Association*

v. Smith, 278 U. S. 646, No. 449, October term, 1928, U. S. Supreme Court on petition for certiorari, pp. 142, 143, 145, 60, 61, 67 to 70, 72. For File Wrapper see also same record, p. 209, 210.

—IV—

Specification of Errors.

The Sixth Circuit Court of Appeals erred in finding and holding:

(1) That Patent No. 1,379,224, Claims 1 and 2 are not infringed by respondents.

(2) That Patent No. 1,507,440 is invalid, and in failing to find and hold that said Patent is valid and the claims thereof infringed by respondents.

(3) That Patent No. 1,507,439 is not infringed by respondents; and in refusing to hold that said patent is valid and infringed.

—V—

Argument.

Summary of Argument.—(1) As to Patent No. 1,379,224, Claims 1 and 2. Considering that respondents' apparatus and the apparatus described in *American Electric Rabbit, etc., et al., v. Smith, 26 Fed. (2nd) 1016*, and *Smith v. American, etc., 21 Fed. (2nd) 366*, are substantially identical and in each apparatus the respondents in this case and the defendants in the Fifth Circuit Court of Appeals case have placed the apparatus on the infield or left outer-side of the race course and substitute a rigid for

the movable support of the arm described and claimed in the patent, it is urged that:

Point A. The decision below is contrary to and in conflict with the prior decision of the Fifth Circuit Court of Appeals on the same matter.

(2) As to Patent No. 1,507,440, considering that the respondents' housing is substantially identical with the housing described in the Fifth Circuit Court of Appeals case, it is urged that:

Point B. The decision below is contrary to and in conflict with the decision of the Fifth Circuit Court of Appeals.

(3) As to Patent No. 1,507,439, Claim No. 1, considering that respondents' starting cage and the starting cage described in *American, etc., v. Smith, 26 Fed. (2nd)*, and *Smith v. American, 21 Fed. (2nd) 366*, are substantially identical, and in each apparatus, (except as to the location of the inclined members) respondents in this case and the defendants in the Fifth Circuit Court of Appeals case substituted wooden board partitions for wire mesh partitions and elastic rubber springs for springs called for in the claim, it is urged that:

Point C. The decision below is contrary to and in conflict with the decision of the Fifth Circuit Court of Appeals on the same matter.

Point A.

The decision below is contrary to and in conflict with the decision of Fifth Circuit Court of Appeals on the same matter.

Conclusions of the Fifth Circuit Court of Appeals in *American Electric Rabbit, etc., v. Smith, 26 Fed. (2nd), 1016,* in agreement with *Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366,* are as follows: (1) By this Patent, (No. 1,379,224) Smith, patentee, has substantially advanced the art entitling the patent and its claims to a liberal construction and to a range of equivalents commensurate with the scope of his invention *(Smith v. American Electric Rabbit, etc., 21 Fed. [2nd] 366,* at *page 371);* (2) the essence of the invention described and claimed in Claims 1 and 2 is the horizontal-lure-carrying arm extending through the longitudinal opening of the casing in a projecting position over the track. *(Ibid., 21 Fed. [2nd] 366,* at *pages 368, 371, 372);* (3) the location of the apparatus and the form of movable or wheel support of the hinge-mounted horizontal arm are not of the essence of the invention, that no limitation was imposed by the prior art or regarded as essential in the Patent Office proceedings *(Ibid., 21 Fed. [2nd],* at *pages 368, 371),* and no disclaimer of equivalents therefor *(Ibid., 21 Fed. [2nd] 366,* at *pages 370, 371);* (4) that the arm rigidly connected to the conveyor car is the obvious equivalent of the hinged arm supported by a wheel, constituting a formal alteration and a deliberate evasion of the claims *(Ibid., 21 Fed. [2nd] 366,* at *pages 371, 372);* (5) that there is nothing to show his (Smith's) intention to relinquish all forms in which his invention might be embodied. *(Ibid., 21 Fed.*

[*2nd*], at *page 371)*; (6) that the transposition of the apparatus from the outfield outer side of the race course to the infield or left outer side of the race course did not avoid infringement of Claim No. 1, and further that such transposition is provided for in Claim No. 2 *(Ibid., 21 Fed.* [*2nd*], at *pages 369, 370)*; (7) defendants have thereby infringed.

Each and every one of these conclusions are controverted by the decision of the Sixth Circuit Court of Appeals. The said Sixth Circuit bases its conclusion of disclaimer or express limitation on the patent office proceedings or File Wrapper, but fails to point out where the so-called disclaimer or express limitation is to be found, whereas the Fifth Circuit Court of Appeals not being able to discover any disclaimers, estoppels or express limitations anywhere within the four corners of the Patent or the File Wrapper says:

> "A reading of his claim in the light of his specifications does not suggest an intention to restrict himself to the use of the wheel and hinge on the projecting arm, which might well have been rigid instead of flexible as far as function and operation were concerned. **There is nothing** to show his intention to relinquish to the public all forms in which his invention might be embodied."
>
> *21 Fed. (2nd), at page 371*; see also *page 368.*

It is believed inappropriate at this time to point out the errors in the decision below. Albeit, comparison between the structure described in the decisions of each Fifth and Sixth Circuit Courts of Appeal, evidences such an identity as to call for review by certiorari in order to remove the conflict.

Point B.

The decision below holding that Patent No. 1,507,440 is invalid is contrary to and in conflict with the decision of the Fifth Circuit Court of Appeals holding that this patent is valid and the claims infringed.

Adherence to Rule 38, Sec. 2, enjoins repetition in disclosing the manifest conflict, aside from the confession of variance by the Sixth Circuit Court of Appeals, all as set forth in the petition and reasons for allowance of the writ. (See under heading of Reasons for allowance of the writ; see also R. pp. 100 and 368, 372; see also *Smith v. American, etc., 21 Fed.* [*2nd*], *at page 373).*

Point C.

The decision below as to the single claim of Patent No. 1,507,439 is contrary to and in conflict with the decision of the Fifth Circuit Court of Appeals on the same matter.

As to this starting cage patent, the decision of non-infringement by the Court below on the substitution of wooden board partitions for wire mesh partitions, of non-divergent for divergent inclined members in the plane of the side walls, and of elastic rubber springs for springs, seems to be predicated on an undisclosed express or implied limitation to be searched for in the patent itself, the file wrapper and the prior art from which it is deduced as to these elements "that if the patent is valid it must be given a relatively narrow range." But aside from the

patent specifications and special reservation therein against form, material and location, the prior horse-starting art (assuming *arguendo*, that it is analogous to the dog-starting art) and the File Wrapper, each and all of which is believed to overthrow the Sixth Circuit decision, the Fifth Circuit Court of Appeals by adopting the conclusions in *21 Fed. (2nd), supra*, at *pages 374, 375, 376*, is decidedly at variance with the Sixth Circuit, in that these trivial changes are obvious equivalents and colorable evasions. Reduced to their final analyses, these two decisions are clearly in conflict; in one, the elements of the claim are to be held verbally definitive and no equivalents allowable; in the other, a reasonable range of equivalents is permitted particularly as to these accessorial elements described and claimed in the patentee's expressly stated preferred form of location and material with no substantial change in function, operation and result and pertaining solely to the working environment of the inventive step of a single front door hinged at its upper end to the top walls of the frame in combination with inclined members secured to the top of the frame and extending upwardly and outwardly. And furthermore, inasmuch as each decision rests upon the face of the patent in connection with facts and documentary evidence of such a nature and effect as not to be reasonably disputed, the conflict invites a question of law, and which of the two decisions is correct.

Singer v. Cramer, 192 U. S. 265, 275.

Sanitary Ref. Co. v. Winters, 280 U. S. 30.

The novelty of this patent was discussed in the Fifth Circuit decision *(21 Fed. [2nd] 374, 375, 376)*, its validity assumed and its scope determined. In its opinion, the

Sixth Circuit Court of Appeals thought that "the elements in question as well as the other elements, are but forms of construction that might be thrown together if occasion demanded or necessity arose, by any one who is skilled in the building art." In view, however, of its decision unqualifiedly affirming the decree of the District Court (R. p. 368) decreeing and deciding that "the patent and its only claim is valid, but not infringed" (R. p. 100), accordingly, the decision of the Sixth Circuit is, that the claim is valid but not infringed—all in conflict with the Fifth Circuit decision.

CONCLUSION.

As to Patent No. 1,379,224 and No. 1,507,440 this Court has granted certiorari in No. 809, October term 1929, No. 77, October term 1930, entitled *Smith v. Magic City Kennel Club, Inc., et al.*, on petition for certiorari to the Tenth Circuit Court of Appeals, it is therefore respectfully submitted that this case is one calling for the exercise by this Court of its supervisory powers, in order that a conflict of decision between the Fifth and Sixth Circuit Courts of Appeal as to the three patents in suit and on the same matter may be removed, and that to such an end a writ of certiorari should be granted and this Court should review the decision of the United States Circuit Court of Appeals for the Sixth Circuit and finally reverse it.

Respectfully submitted,

JOHN E. SATER,
E. HOWARD M'CALEB,
Counsel for Petitioner.